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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Kazuki Matsui

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STAAS & HALSEY LLP

SUITE 700

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EXAMINER

CARLSON, JEFFREY D

ART UNIT

PAPER NUMBER

3622

MAIL DATE

DELIVERY MODE

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/855,775	<b>Applicant(s)</b> MATSUI ET AL.	
	<b>Examiner</b> Jeffrey D. Carlson	<b>Art Unit</b> 3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 12 June 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-3,6-12 and 15-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3,6-12 and 15-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>4/30/08</u> .   | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. This action is responsive to the paper(s) filed 4/30/08.

#### ***Claim Objections***

Claim 19 is objected to because of the following informalities:

- Claim 19, "first second" should be replaced by "first terminal".

#### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 17, 18 are rejected under 35 U.S.C. 112, second paragraph, as indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- Claim 17, the "sending an acquisition request" paragraph is unclear. Does the "from the 2<sup>nd</sup> terminal to the intermediating terminal" refer to the 'direction' of the "sending" or to the 'direction' of the 'acquiring'? "Requesting an acquisition request" is also confusing. Is an entity requesting an acquisition or actually requesting a request?
- Method claim 18 begins with a positive step of providing a symbol, but then references a previous reception of the symbol (received from). While the step of providing is clear, it is unclear whether the past-tense step of "received from" is to be positively set forth as a required step in this claim. Applicant

should positively require a step of "receiving" before the step of "providing" if this previous step of receiving is to be a positive limitation on the claim scope.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. **Claim 17 is rejected under 35 U.S.C. 102(e) as anticipated by Bezoz (U.S. Patent No. 6,525,747).**

7. As best understood regarding claim 17, Bezoz teaches furnishing network resource symbols to the user terminals (FIG. 1); setting up in advance a correspondence table in which identifiers for the virtual spaces and identifiers for the symbols are correlated (FIG. 11 at 1105); providing an intermediating terminal enabling

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communication with the user terminals, and based on the correspondence table enabling conversion between the symbol identifiers and the virtual-space identifiers (FIG. 9 at 904); sending the symbol identifiers from the user terminals to the intermediating terminal (FIG. 1); and reporting from the intermediating terminal to the user terminals the virtual-space identifiers that correspond to the symbols (FIGs. 5-7, 12), wherein based on the reported virtual-space identifiers the user terminals participate in the virtual spaces and initiate communication with other user terminals having the same symbols (FIGs. 12-13). The steps of sending an acquisition request, requesting a symbol and its identifier and sending the symbol and symbol identifier are inherently met by the process of a second user navigating to the web page for a particular item, receiving from the server the visual symbols to join a discussion (with at least a first user) as well as the underlying code/identifiers that when clicked by the second user, enable the user to join user one in the virtual discussion space in accordance with the predetermined correspondence table of Bezos. Further, a user clicking a particular symbol results in reporting of that symbol and identifier for the symbol to the server for processing (i.e. the server receives the symbol and identifier), so that the user can create/join/add to a discussion. Anytime a user downloads the page having the symbols for the merchandise, the browser cause the terminal to store the symbol, identifiers, and all other code/objects rendered as part of the webpage.

**8. Claims 18, 19 are rejected under 35 U.S.C. 102(e) as anticipated by Bezos (U.S. Patent No. 6,525,747) or, in the alternative, under 35 U.S.C. 103(a) as obvious over Bezos.**

9. Regarding claim 18, generally, Bezos teaches shopping (merchandise) related discussions (chat) conducted using hyperlinked (identifiers) text (symbols) among shoppers using a server (communication intermediating device) including tables based on Item/Participant/Discussion IDs (a correspondence table). The merchandise includes symbols representative of the merchandise, including at least 101 of fig 1. While the “received from” language is not taken to positively require a particular method step (as outlined above in the 112 section), the webserver that provides the elements on the web page is a server that provides the visuals symbols which are hyperlinked to the appropriate virtual discussion areas. The HTML code and/or other used elements (icons, etc.) are taken to be stored on a storage device accessible by the webserver so that the webserver can deliver the page elements to the user’s browser, thereby providing a symbol “received from a first electronic device”. Another interpretation would be that the user’s browser “provides” (i.e. downloads and renders the symbol) which is a symbol received from the webserver. The link to join a discussion (104 – fig 1) for that merchandise item represents a virtual chat space identifier as this leads the user to a virtual discussion where the user can communicate with others virtually about the item. This email-based discussion is taken to represent a “chat”<sup>1</sup>. However, it would have been obvious to one of ordinary skill at the time of the invention to have

provided any well known means for user-to-user electronic discussion, including an IRC chat as is generally well known and established.

10. Regarding claim 19, the step of two users requesting and receiving the webpage of Bezos provides that the downloaded/rendered/cached merchandise symbol is not only stored by a first terminal, but that the second terminal requests (and receives) the symbol that is stored by the first terminal. When the first terminal indicates a desire to start/join/add a discussion, this is a step of transmitting the associated symbol to the server for processing. If both terminals indicate a desire to discuss in association with the symbol, the server enables the terminal to communicate with each other about the associated merchandise. The link to join a discussion (104 – fig 1) for that merchandise item represents a virtual chat space identifier as this leads the user to a virtual discussion where the user can communicate with others virtually about the item. This email-based discussion is taken to represent a “chat”<sup>2</sup>. However, it would have been obvious to one of ordinary skill at the time of the invention to have provided any well known means for user-to-user electronic discussion, including an IRC chat as is generally well known and established.

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<sup>1</sup> Chat – To converse in an informal or familiar way. An informal or familiar conversation. Webster's II New Riverside University Dictionary, 1988, Houghton Mifflin Company, pg 251.

<sup>2</sup> Chat – To converse in an informal or familiar way. An informal or familiar conversation. Webster's II New Riverside University Dictionary, 1988, Houghton Mifflin Company, pg 251.

***Allowable Subject Matter***

Claims 1-3, 6-12, 15, 16 appear to contain allowable subject matter.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey D. Carlson whose telephone number is 571-272-6716. The examiner can normally be reached on Monday-Fridays; off alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571)272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jeffrey D. Carlson/  
Primary Examiner, Art Unit 3622

Jeffrey D. Carlson  
Primary Examiner  
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jdc